



Patent
Case No.: 57453US002

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First Named Inventor: FLEMING, PATRICK R.
Application No.: 10/051745 Group Art Unit: 3763
Filed: January 15, 2002 Examiner: LoAn H. Thank
Title: MICRONEEDLE DEVICES AND METHODS OF MANUFACTURE

OFFICIAL

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF TRANSMISSION

To Fax No.: 703-872-9306.
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on:

Nov. 26, 2003 Carrie M. Arcand
Date Signed by: Carrie M. Arcand

Dear Sir:

This is in response to the Office Action mailed October 31, 2003. Claims 1-62 are pending. Claims 1-62 were restricted under 35 USC § 121 as follows:

- I. Claims 1-35, drawn to a microneedle device, classified in class 604, subclass 173.
- II. Claims 36-62, drawn to a method of manufacturing, classified in class 228, subclass 110.1.

Applicants provisionally elect Group I (i.e., claims 1-35), with traverse, and respectfully request reconsideration and withdrawal or modification of the restriction requirement. The traversal has two parts. First, applicants respectfully request clarification as to the reasons for the restriction requirement. It is unclear which of the identified species by figure number correspond with the claims. In accordance with MPEP §809.02(a)(B), the Examiner must “[c]learly identify each ... of the disclosed species, to which claims are restricted. If the species *cannot be conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted.”

Second, applicants respectfully submit that the public will be better served if only one patent issues from the enclosed specification. The Examiner is in the best position to fashion

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searches for these various claims. However, applicants suspect that, at the very least, there will be overlap for the various claims in these Groups. Instead of requiring two file histories for the inventions in this case, if the restriction requirement is withdrawn, there will only be one for the presently claimed invention. Further, if the case is divided into two cases, applicants will be forced to pay the additional maintenance fees associated with two cases.

The Examiner also imposes a species election requirement with respect to the claims. Specifically, the Examiner identifies the following allegedly patentably distinct species:

- Species I: Figs. 1-2a;
- Species II: Fig. 7;
- Species III: Figs. 8-10;
- Species IV: Figs. 11-12;
- Species V: Fig. 13;
- Species VI: Fig. 14; and
- Species VII: Fig. 15;

Applicants elect for examination, with traverse, the species identified by the Examiner in Figs. 1-2a. Applicants traverse because, for the reasons already stated with respect to the restriction requirement, examination of all restricted species does not pose an undue burden. Additionally, it is not clear which claims the Examiner intends to examine for the various species. All claims identified in Group I are believed to read on the elected species, and consideration of all pending claims is respectfully requested once the generic claims are found to be allowable.

Conclusion

Applicants have elected Group I. Continued prosecution of this application is respectfully requested.

It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723. The Examiner is invited to contact the undersigned at the indicated telephone number with questions that can be resolved with a simple teleconference.

Respectfully submitted,

By:

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11/26/03
Date

Office of Intellectual Property Counsel
3M Innovative Properties Company